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Gerard J Barry

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MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP  
300 S. WACKER DRIVE  
32ND FLOOR  
CHICAGO, IL 60606

EXAMINER

TINKLER, MURIEL S

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### **DETAILED ACTION**

This application has been reviewed. Claims 1, 5-9, 11-15, 27 and 28 have been amended. Claims 25 and 29 have been cancelled. Claim 30 has been added. Therefore, claims 1-24, 26-28 and 30 are pending. The rejection(s) are as follows.

**Please note:** The Examiner spoke with Applicant's representative Michael D. Clifford on January 5, 2008 regarding the Final Office Action mailed on November 21, 2008. The Applicant's representative pointed out that the finality of the Office Action was in question because of a contradictory statement in the Office Action. This statement was located in the 'Conclusion' section of the office action and states, "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action". Although there were amendments to the claims, these amendments did not necessitate a new grounds of rejection, as shown in paragraph 2 on page 2 of the office action mailed on November 21, 2008. The Examiner understands how this can be confusing. Therefore the Examiner has attached a copy of the office action with the contradictory statement in the 'Conclusion' section removed. The finality of the Office Action mailed on November 21, 2008 stands.

### ***Response to Amendment***

1. The amendments to claims 1, 5-9, 11-15, 27 and 28 have been reviewed against the specification and accepted for examination. The amendments to these above mentioned claims have overcome the 35 USC 112, second paragraph rejection.

***Response to Arguments***

2. Applicant's arguments filed June 19, 2008 have been fully considered but they are not persuasive. The Applicant has amended independent claims 1, 15, 27 and 28 and added new claim 30. These amendments simply clarify the claims and do not necessitate a new grounds or rejection.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-11 and 14, 22, 25-28 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Prasad (EP 1058217), hereafter referred to as Prasad.

5. Regarding claims 1, 15 and 25-29, Prasad discloses: (see claim 4, figs. 1 and 3; Par. 0025-0087) a method, performed by a computer system (fulfillment center 20) having a network of terminals (ATMs), of transferring funds from a first payment cardholder (Sibling card 22) at a first merchant (ATM 26) to a second payment cardholder at a second merchant (ATM 28), said method comprising the steps of:

a. receiving an indication from said first cardholder (Sibling card 22) at said first merchant that a transfer of funds is required to said second cardholder (Sibling card 24);

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- b. generating a first payment card transaction at a networked terminal (ATM) between said first merchant (ATM 26) and said first cardholder (Sibling card 22), wherein said first payment card transaction is a first immediate (real time) transfer, debiting said funds from said first cardholder (Sibling card 22) and crediting said funds to said first merchant (ATM 26);
  - c. generating a second payment card transaction at a networked terminal (ATM 28) between said second merchant and said second cardholder (Sibling card 24), wherein said second payment card transaction is a second immediate transfer, debiting said funds from said second merchant and crediting said funds to said second cardholder; and
  - d. communicating said first and second payment card transactions to a host (fulfilment center 20) across said network.
- 6. Regarding claims 2 – 4, 16-18 and 22, see Prasad, claim 1; paragraphs [0043, 0064].
  - 7. Regarding claim 5, see Prasad, fig. 4 and description.
  - 8. Regarding claims 6 and 19, see Prasad, paragraph [0064] currency exchange module 46.
  - 9. Regarding claims 7 and 20, see Prasad, claim 1.
  - 10. Regarding claims 8 and 21, see Prasad, paragraph [0080].
  - 11. Regarding claims 9-11 and 30, see Prasad, paragraph [0085].
  - 12. Regarding claim 14 see Prasad, paragraph [0031].

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 12, 13, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prasad as applied to claims 1 and 22 above, and further in view of Meyer et al. (US 2002/0128967), hereafter referred to as Meyer.

15. Regarding claims 12, 13, 23 and 24, Prasad discloses the information in claims 1 and 22. Prasad does not specifically disclose the act of identifying a suitable first/second merchant from details of the first/second cardholder. Meyer discloses the act of person-to-person money transfers using a unique barcode, an example of this is discussed in paragraphs 27-29. Therefore, it would have been obvious to use the concepts of person-to-person money transfers as taught by Meyer in Prasad because it combines well known techniques transferring funds via (electronic mail).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MURIEL TINKLER whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 6:30 AM until 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. T./

Examiner, Art Unit 3691

/Hani M. Kazimi/

Primary Examiner, Art Unit 3691